

REMARKS

I. The Rejections under DOUBLE PATENTING

A terminal disclaimer was sent in with the last amendment to overcome the rejection of DOUBLE PATENTING.

II. The Rejections Under 35 U.S.C. § 102(b)

Claims 80-83, 87, 88 and 90-97 stand rejected under 35 U.S.C. § 102(b) “as being anticipated by U.S. Patent No. 3,537,006 to Hanson” (“Hanson”). The Official Action provides that:

Regarding claim 80, Hanson discloses first and second backing members (fig.2:96 &91), a first structure (fig. 2:50) attached to the first backing and indirectly through studs 82 & 72 to eth second backing member (fig. 2:91). The backing members are spaced from each other (fig. 2: see gap adjacent 85) with two upright studs (fig. 2: 82 & 72) and the second backing member is capable of being disposed between the second stud (fig. 2: 72) and a third stud (fig. 1: see plurality of panel backing) and the second end of the first backing member (fig.2:96) is adjacent to the second stud (fig. 2: 72).

For a reference to properly anticipate the subject matter of a claim, the reference must disclose each and every claimed element in the same form as recited in the claim. As will be discussed below, Hanson fails to disclose each and every element of claims 80-83, 87, 88 and 90-97.

This rejection is respectfully traversed.

**INDEPENDENT CLAIMS 80, 90 AND 96, REPRODUCED BELOW WITH
COMMENTS AND REFERENCE NUMBERS FROM HANSON, CLEARLY DO
NOT READ ON THE HANSON STRUCTURE:**

The first numbers inserted in to the claims below for reference purposes only refer to the reference numerals in the instant application drawings. The numbers in italics following the reference numerals of this application refer to the Hanson 3,527,006 structure as being applied in the rejection. Comments within the claims are in (parenthesis).

80. (As Amended on Oct. 15, 2005) An apparatus for providing backing for studs in a wall, said backing apparatus comprising:

a first backing member (13) (*96 of Hanson*) having a first end and a second end;

a second backing member (14) (*91 of Hanson*) having a first end and a second end; and

a first substantially planar structure (19) (*50 of Hanson*) operatively attached to said first and second backing members (13, 14) (*96, 91 of Hanson*) for spacing the second end of the first backing member 13, **96** a predetermined distance from the first end of the second backing member 14, **91** whereby the first backing member 13, **96** can be placed *between* a first upright stud (see the stud with 11b on it in Fig. 1 of the instant application-we will call this stud 11b for this discussion, *82 of Hanson*) and a second upright stud (the stud to the right of 11b) (*72 of Hanson*) spaced from the first upright stud 11b, **82** and whereby the second backing member 14, **91** can be disposed *between* the second upright stud 72 and a third upright stud spaced from the second upright stud such that the second end of the first backing member 11b, **82** is adjacent to and on one side of the second upright stud 72 and the first end of the second backing

member **14, 91** is adjacent to and on another side of the second upright stud **72**.

(Emphasis in *italics*.)

NOTE:

Hanson does not have this structure of claim 80:

“whereby the first backing member **13, 96** can be placed *between* a first upright stud (**see the stud with 11b on it in Fig. 1-we will call this stud 11b for this discussion, 82**) and a second upright stud (**the stud to the right of 11b, 72**)”. (Emphasis in *italics*.)

SIMILARLY:

Hanson does not have this structure of claim 80:

“whereby the second backing member **14, 91** can be disposed *between* the second upright stud **72** and a third upright stud” (Emphasis in *italics*.), i.e. the second backing member is not *between* the second stud **72** and the third stud.

In Hanson, the first backing member **96** is NOT *between* the first upright stud **82** and the second upright stud **72**. A flange **85** of the “first upright stud **82**” is between the first backing member **96** and the second backing member **91**. This is a big difference from what is claimed.

ALSO:

Moreover, as recited in the preamble of claim 80, the present invention is for a structure to provide backing for studs *in* a wall. Items **90, 91, 95 and 96** represent the wallboard panels themselves and therefore cannot function as a backing member for studs within a wall. *See e.g., Hanson, col 5, lns. 20-28.* In partition construction as in Hanson (e.g., cubicles), both sides of the wall are exposed and thus neither set of wallboard panels (e.g., **91, 96**) can be distinguished as a backing member as compared to the other

set (e.g., 90, 95). Likewise, none of the wallboard panels of Hanson serve to describe structure that is within a wall. *See* Hanson, col. 1, lns 50-54. The studs of Hanson connect to partitioned trackway pieces (e.g., **24 and 50**) that are also connected to the floor or ceiling. *See* Hanson, col. 4, lns. 36-49. As such, these trackway pieces are C-shaped and the substantially planar portion **50** is in a different plane than the studs.

90. (As Amended on Oct. 15, 2005) A wall comprising:
- a first upright stud **82**;
 - a second upright stud **72** to one side of and spaced from the first stud;
 - a third upright stud to one side of and spaced from the second stud;
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Not in Hanson:

a first backing member **96** disposed *between* the first and second studs **82, 72**;
a second backing member **91** disposed *between* the second and third studs; and
a first substantially planar structure **19, 50** operatively attached to the first and second backing members *and spanning therebetween*, said first structure further being attached to at least one of the first, second or third upright studs. (Emphasis in *italics*.)

Clearly the Hanson member **50** is **BELLOW** the first and second backing members **96 and 91**, not *between* them. Additionally, there is no teaching within Hanson that member 50 extends beyond the length of one wallboard panel module (18 or 20) in order to connect to more than one “backing member.” It appears that each trackway piece (24

or 50) is merely as long as each set of wallboard panels and thus does not anticipate the planar structure of the present invention. *See e.g.* col. 4, lns 54 – 55; and col. 5, lns 29 – 45.

96. (As Amended on Oct. 15, 2005) A wall comprising:

a first upright stud **82**;

a second upright stud **72** supported in spaced apart relation to the first upright stud to define a first space therebetween;

a third upright stud supported in spaced part relation to the second upright stud to define a second space therebetween;

a fourth upright stud supported in spaced apart relation to the third upright stud to define a third space therebetween;

Not in Hanson:

a first backing member **96** sized to be received in the first space and extend between the first and second upright studs **82, 72**; (The first backing member **96** is NOT *between* studs **82 and 72**.)

a second backing member **91** sized to be received in the second space and extend *between* the second and third upright studs; (**Not between.**)

a third backing member sized to be received in the third space and extend *between* the third and fourth upright studs; and (**Not between.**)

a substantially planar spacer 19, **50** attached to the first, second and third backing members **96, 95, ?** of Hanson and at least one of the first 11b, **82, second 11, 72**, third, and fourth 16, upright studs such that the first backing member 13, is supported in the first space and the second backing member is supported in the second space and the third backing member is supported in the fourth space. (Emphasis in *italics*.)

(*Studs 82 and 72 do not have any backing members, (96 or 91), between them.*)

The Official Action asserts that the wallboard panels 96 & 91 of Hanson comprise “first and second backing members”. As can be seen in Figure 2 of Hanson, the wallboard panels 96 and 91 are exterior panels and do not comprise backing members. For this reason alone, Hanson cannot anticipate the subject matters of claims 80-83, 87, 88 and 90-97. Furthermore, independent claim 80 has been amended to clarify that the first structure is substantially planar. The Official Action asserts that the trackway 50 of Hanson comprises a first structure. However, the trackway 50 of Hanson is not substantially planar.

Hanson provides that “trackway 50 includes a central horizontal panel 52 and flanking vertically disposed side panels 53 and 54, formed integrally with the horizontal panel 52 and extending upwardly therefrom.” See column 4, lines 19-22. Trackway 50 is not substantially planar and for this reason, in addition to the foregoing reason, Hanson cannot anticipate the subject matter of claim 80.

With respect to claim 82, the Official Action asserts that the central panel 26 of the trackway 24 comprises the recited central structure. Claim 82 has also been amended to clarify that the second structure is substantially planar. The trackway 24 is not substantially planar. See, column 3, lines 42-47 of Hanson. Thus, Hanson cannot anticipate the subject matter of claim 82.

Claims 83, 87 and 88 all depend (either directly or indirectly) from claim 80 which, as was discussed above, is not anticipated by Hanson. Accordingly, it also follows that the subject matters of dependent claims 83, 87 and 88 are also not anticipated by Hanson.

Claim 90 has been amended to clarify that the first structure is substantially planar and claim 91 has been amended to clarify that the second structure is substantially planar. Thus, Hanson fails to anticipate the subject matters of claims 90 and 91 for the same reasons that Hanson fails to anticipate claims 80 and 81 as was discussed above.

III. The Rejections Under 35 U.S.C. § 103

Claims 84-86 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hanson. As explained above in detail, Hanson does not have the basic structure claimed. **Consequently these claims 84-86 do not read on the hypothetical structure of Hanson as modified in this rejection.** As indicated above, Hanson fails to disclose the use of backing members. Hanson fails to teach the use of a substantially planar first structure attached to first and second backing members and which spans therebetween. The trackways 24 and 50 of Hanson are substantially C-shaped for supporting the ends of the vertically extending studs therein. See column 4, lines 54-70 and Figures 2 and 4 of Hanson. The Official Action fails to point to any motivation in Hanson that would have

led a person of ordinary skill in the art to make the trackways 24 and 50 substantially planar. In fact, if one were to make the trackways 24 and 50 substantially planar, they would not be suited to support the ends of the vertical studs therein. Accordingly, a *prima facie* case of obviousness has not been established with respect to claims 84-86.

Claim 89 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hanson in view of U.S. Patent No. 3,680,271 to Satchell ("Satchell"). Claim 89 depends indirectly from claim 80. **Claim 89 does not read on the structure of Hanson in view of Satchell as proposed in the rejection.** Furthermore, as was discussed above, Hanson fails to provide the requisite motivation to modify the trackways disclosed therein to make them substantially planar. Satchell also fails to provide that motivation. Accordingly, even if one were to combine the teachings of Satchell with the teachings of Hanson, the resulting combination would not satisfy the recitations of claim 80 and/or claim 89 that depends from claim 80.

IV. SUMMARY

Accordingly, since all pending claims 42-97 are believed to be clearly allowable, a notice to that effect is earnestly solicited.

The undersigned attorney hereby invites Examiner Katcheves to call to discuss this matter if a Notice of Allowance is not going to be issued.

Respectfully submitted,

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